

REMARKS

Claims 1-3, 5-10 and 12-68 are pending in the current application. claim 5 is currently amended. Claims 4 and 11 are canceled.

Double Patenting

Claims 1-3, 5-10, and 12-68 are provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 8, 35, and 38 of co-pending Application No. 10/543,088.

Applicants note the Examiner's position. However, Applicants submit that until either the present application, or one of U.S. Patent Application No. 10/543,088 issues into a patent, this rejection is premature (as acknowledged by the provisional status of the rejection).

Claim Rejections – 35 U.S.C. § 112

Claims 5 and 7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner objects to the word "it" in claim 5 for being indefinite. The Examiner objects to claim 7 for depending from claim 5. Applicants respectfully submit claim 5 has been amended to address the Examiner's objection and now meets the requirements of 35 U.S.C. § 112, second paragraph.

Therefore, Applicants respectfully request the rejection of claims 5 and 7 under 35 Y.S.C. § 112, second paragraph be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 1-3, 6, 8-10, 13, and 15-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hammond et al. (US 6,686,840, hereinafter “Hammond”) in view of Brinkmeyer et al. (US 2001/0028295, hereinafter “Brinkmeyer”).

Claim 1 recites “wherein the receiver is deactivated when the security unit shifts to the connect mode”. The Examiner admits Hammond fails to teach this limitation. The Examiner then asserts that Brinkmeyer teaches this limitation, and that it would be obvious to combine the teachings of Brinkmeyer with those of Hammond. Applicants respectfully disagree.

Applicants direct Examiner’s attention to MPEP § 2143.01(V) which states: “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)”. Applicants respectfully submit the combination of Hammond and Brinkmeyer suggested by the Examiner would render the device taught by Hammond unsatisfactory for its intended purpose, and thus, cannot be obvious.

Hammond teaches a system including a receiver 36 within an alarm housing 32. The Examiner appears to read the receiver recited in claim 1 on the receiver 36 taught by Hammond. Hammond teaches that the receiver can receive signals from a transmitter 16 which can transmit various signals based on the state of buttons 18 and 20 (*Hammond*: FIG. 1, col. 2, ln. 56- col. 3, ln. 13). Hammond teaches an “automatic mode” where transmitter 16 continuously sends range signals to receiver 36 and an alarm is activated if the range signals are not received by receiver 36. Further, Hammond teaches an “alarm mode” where an alarm can be activated in response to transmitter 16 sending a predetermined signal to receiver 36 (*Hammond*:

col. 3, ln. 51- col. 4, ln. 2). Thus, both the “automatic” and “alarm” modes **require** receiver 36 to be in **continuous operation** in order to function properly.

The Examiner asserts Brinkmeyer teaches deactivating a receiver when a security unit shifts to connect mode. Paragraph [0029] of Brinkmeyer discusses a process whereby a receiver is periodically activated to receive “use-enabling radio information” and then deactivated. The Examiner proposes applying the teachings of Brinkmeyer to the receiver of Hammond, thus resulting in deactivating the receiver 36. However, as is stated above, both the “automatic” and “alarm” modes of the system taught by Hammond require constant operation of the receiver 36. Specifically, if the receiver 36 taught by Hammond is modified to be deactivated as the Examiner suggests, the system taught by Hammond would no longer be able to function in “automatic mode” because the deactivated receiver 36 would not be able to sense any of the range signals being sent continuously from the transmitter 16. Further, if the receiver 36 taught by Hammond is modified to be deactivated as the Examiner suggests, the system taught by Hammond would no longer be able to function in “alarm mode” because the deactivated receiver 36 could not sense the predetermined signal sent by transmitter 16. Accordingly, modifying the system taught by Hammond in the manner suggested by the Examiner would render the system taught by Hammond not only unsatisfactory, but entirely non-operational with respect to the intended purpose of operating in either of the “automatic” or “alarm” modes disclosed by Hammond. According to MPEP § 2143.01(V), such a combination cannot be obvious, and thus, cannot be used to support a *prima facie* case of obviousness.

Further, the following has been held:

"rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

(*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006))

Accordingly, Examiner must articulate some reasoning supporting a finding of obviousness. The Examiner states on page 4 of the Office Action that it would have been obvious to incorporate the teachings of Brinkmeyer into the system of Hammond in order to "accurately detects theft attempts thereby increasing the safety of the system". However, this assertion is not supported by any of the cited art or any other source identified by the Examiner. To the contrary, for the reasons stated above, modifying the system taught by Hammond in the manner suggested by the Examiner would result in a non-functional security system which could not detect theft attempts while the receiver 36 is deactivated. Consequently, the Examiner has failed to identify a rationale supporting the conclusion of obviousness as is required to support a *prima facie* case of obviousness.

Accordingly, for at least the reasons stated above, Applicants respectfully submit the Examiner cannot establish a *prima facie* case of obviousness with respect to claim 1, or any claims depending from claim 1, as is required to support a rejection under §103.

Additionally, claim 8 contains limitations at least somewhat similar to those of claim 1. Consequently, at least by virtue of the similarity between claim 8 and claim 1, the Examiner cannot establish a *prima facie* case of obviousness with respect to claim 8, or any claims depending from claim 8, as is required to support a rejection under §103.

Therefore, Applicants respectfully request the rejection of claims 1-3, 6, 8-10, 13, and 15-34 under 35 U.S.C. § 103 be withdrawn.

Claims 35-37, 39, 41-44, 52-58, 61 and 63-68 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Howell (US 5,955,948, hereinafter "Howell") in view of Brinkmeyer.

Claim 35 recites "a connect mode in which the receiver is deactivated". The Examiner admits Howell fails to teach this limitation. The Examiner then asserts that Brinkmeyer teaches this limitation, and that it would be obvious to combine the teachings of Brinkmeyer with those of Hammond. Applicants respectfully disagree.

Applicants again direct Examiner's attention to passage from MPEP § 2143.01(V) quoted above. Further, Applicants respectfully submit the combination of Howell and Brinkmeyer suggested by the Examiner would render the device taught by Howell unsatisfactory for its intended purpose, and thus, cannot be obvious.

Howell teaches a purse alarm system including a purse 12 which includes a purse alarm module 32 (Howell: col. 4, ln. 35-38; FIG. 1). The purse alarm module 32 includes a purse receiver 40. The Examiner appears to read the receiver recited in claim 35 on the purse receiver 40 taught by Howell. The purse receiver 40 of the purse alarm module 32 is connected to the state means 36 for transmitting a clear signal to the state means 36 (Howell: col. 4, ln. 45-48). The purse module 32 includes an alarm 42 which produces an audible alarm upon receipt of an activation signal (Howell: col. 4, ln. 48-51). The state means 36 is configured to continuously produce the activation signal until receipt of the clear signal (Howell: col. 4, ln. 38-41). Accordingly, the purse receiver 40 is **required** to be in **continuous operation** in order to receive and transmit the clear signal to the state means 36.

Further, Howell teaches a portable remote module 60 which includes a remote receiver 66 which is also configured to receive the activation signal. Upon receipt, the activation signal is continuously transmitted to an alarm means 67 which produces an audible alarm during receipt of the activation signal until receipt of the clear signal (Howell: col. 5, ln. 5-26). Accordingly, the remote receiver 66 is **required** to be in **continuous operation** in order to receive the activation signal.

The Examiner asserts Brinkmeyer teaches deactivating a receiver when a security unit shifts to connect mode. As is stated above, paragraph [0029] of Brinkmeyer discusses a process whereby a receiver is periodically activated to receive "use-enabling radio information" and then deactivated. The Examiner proposes applying the teachings of Brinkmeyer to one of the receivers of Howell, thus resulting in deactivating one or both of the receivers 40 and 66. However, as is stated above, the system taught by Howell requires continuous operation of both the receivers 40 and 66. Specifically, if the purse receiver 40 is not in continuous operation, the purse receiver 40 will not receive the clear signal and transmit the clear signal to the purse means 36. Accordingly, the purse means 36 will not discontinue transmitting the activation signal to the purse alarm 42, and the purse alarm 42 will continuously produce the audible alarm **even after a clear signal has been sent**. Further, if the remote receiver 60 is not in continuous operation, the remote receiver 60 will not receive and transmit the activation signal, and the remote alarm 67 will not produce an audible alarm **even though the activation signal has been transmitted**.

Accordingly, modifying the system taught by Hammond in the manner suggested by the Examiner would render the system taught by Howell not only unsatisfactory, but non-operational with respect to the intended purposes of ceasing the production of the purse alarm upon the receipt of a clear signal, and commencing the production of the remote alarm upon receipt of the activation signal, as Howell

teaches. Accordingly the system of Howell would be reduced to a purse alarm that never deactivates while purse receiver 40 is deactivated and a remote alarm that never activates while remote receiver 66 is deactivated. According to MPEP § 2143.01(V), such a combination cannot be obvious, and thus, cannot be used to support a *prima facie* case of obviousness.

Further, as is stated above, *In re Kahn* requires that the Examiner must articulate some reasoning supporting a finding of obviousness. The Examiner states on page 6 of the Office Action that it would have been obvious to incorporate the teachings of Brinkmeyer into the system of Howell in order to “preclude articles from being stolen thereby improving the safety of the system”. However, this assertion is not supported by any of the cited art or any other source identified by the Examiner. To the contrary, for the reasons stated above, modifying the system taught by Hammond in the manner suggested by the Examiner would result in a non-functional security system which would likely increase the chances of articles being stolen while either the receiver 40 or the receiver 66 is deactivated. Consequently, the Examiner has failed to identify a rationale supporting the conclusion of obviousness as is required to support a *prima facie* case of obviousness.

Accordingly, for at least the reasons stated above, Applicants respectfully submit the Examiner cannot establish a *prima facie* case of obviousness with respect to claim 35, or any claims depending from claim 35, as is required to support a rejection under §103.

Additionally, claim 39 depends from claim 38. Applicants assume the Examiner has inadvertently grouped dependent claim 38 with independent claim 35. Accordingly the reasons why the Examiner cannot establish a *prima facie* case of obviousness with respect to claim 39 will be discussed below with respect to claim 38.

Therefore, Applicants respectfully request the rejection of claims 35-37, 39, 41-44, 52-58, 61 and 63-68 under 35 U.S.C. § 103 be withdrawn.

Claims 38, 40 and 45-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Howell in view of Brinkmeyer.

The deficiencies of Howell and Brinkmeyer are discussed above and are relevant here as well because claim 38 contains limitations at least somewhat similar to claim 35. For the reasons stated above, the combination of Howell and Brinkmeyer is improper and cannot be used to support a *prima facie* case of obviousness with respect to claim 35, or any claims depending from claim 35. Accordingly, at least by virtue of its similarity to claim 35, the combination of Howell and Brinkmeyer is improper and cannot be used to support a *prima facie* case of obviousness with respect to claim 38, or any claims depending from claim 38, as is required to support a rejection under §103.

Therefore, Applicants respectfully request the rejection of claims 38, 40 and 45-46 under 35 U.S.C. § 103 be withdrawn.

Claims 47, 49-51, 59-60 and 62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Howell in view of Brinkmeyer as applied to claim 38 above, and further in view of D'Angelo.

The deficiencies of Howell and Brinkmeyer are discussed above and are relevant here because claims 45, 49-51, 59-60 and 62 depend from claim 35. D'Angelo fails to remedy those deficiencies. Accordingly, at least by virtue of their dependence from claim 35, the combination of Howell, Brinkmeyer, and D'Angelo cannot be used to establish a *prima facie* case of obviousness with respect to any of claim claims 47, 49-51, 59-60 and 62 as is required to support a rejection under §103.

Therefore, Applicants respectfully request the rejection of claims 47, 49-51, 59-60, and 62 under 35 U.S.C. §103 be withdrawn.

Allowable Subject Matter

Applicants note with appreciation the Examiner's indication that claims 12 and 14 contain allowable subject matter.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 1-3, 5-10 and 12-68 in connection with the present application is earnestly solicited.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a ~~two~~ (2) month extension of time for filing a reply to the outstanding Office Action and submit the required \$245.00 extension fee herewith.

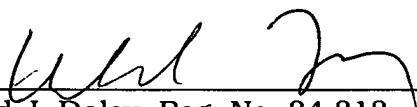
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. §1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By


Donald J. Daley, Reg. No. 34,313

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

J4A
DJD/JHA: tlt